THE UNITED STATES PATENT AND TRADEMARK OFFICE

REISSUE APPLICATION OF:)
)   Merged Proceedings
Inventor: Zvi Orbach   )   ==========================
Application No.: 10/668,094   )
Filed: 09/22/2003   )
Art Unit: 3627   )
Examiner: FISCHER, Andrew J.)   I hereby certify that this
=================================)   correspondence is being e-
REEXAMINATION PROCEEDING   )   filed via EFS-Web for
)   Registered Filers on the
)   date shown below:
Control No.:   90/006,197   )
Filed: 01/17/02   )
For Patent No.: 4,949,257   )   Date: October 6, 2006
For: Automated Merchandising System)
     for Computer Software   )   Signed: _Rachele Wittwer_
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Commissioner for Patents
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Request for Pre-Appeal Brief Conference

Sir:

Applicant requests review of the <u>FINAL</u> rejection, mailed 04/06/06, in the above-identified merged proceeding and requests that this request be filed in both cases together with the Notice of Appeal filed herewith.

1. §102 The anticipation rejection is not a prima facie rejection under 35 U.S.C. 102 because the reference, Freeny, does not meet the claimed identification code parameter limitations. In the rejection, in Section 5, at the top of page 3, paper 2006043, Freeny is said to teach "means for embedding said identification code on the software (within 24)" in which the identification code is "owner codes, catalog reproduce code, or catalog transmit code".
 Freeny does not meet the limitations in independent claim 1 of "means for embedding said identification code on the software carrier" in which "said identification code comprising at least one of the following identification parameters: purchaser

identification, point of sale identification and date of purchase".
Freeny cannot anticipate the invention as claimed because Freeny
is said to teach embedding a different identification code on the
software (in manufacture unit 24) rather than on the software
carrier as claimed.

There are also clear errors in this rejection. The codes as
claimed are purchase or purchaser related codes while the Freeny
codes are held to be owner seller related codes, see paper filed
09/24/03 (in merged reexamination) at page 11-12. The codes as
claimed are embedded in the software carrier while Freeny is said
to embed the codes in the software rather than the carrier.
Finally, Freeny teaches using the owner code and catalog codes as
instructions and authorization from the owner to decipher the data,
e.g. a song, so that the data can be reproduced by reproduction
unit 24 on a material object (see Freeny 10:5-49), rather than
embedding such codes on the software carrier as claimed.

2. §103   The obviousness rejection is not a prima facie rejection
under 35 U.S.C. 103 because no motivation is presented to modify
Freeny in accordance with the rejection. Further, Freny as
modified would not meet the claim limitations. In the rejection,
in Section 10, at page 5, paper 2006043, it is said to be obvious
to modify Freeny to input "purchaser identification such as credit
card authorization information into the manufacturing unit 34".

No motivation for modifying Freeny to produce a software
carrier for distribution with a purchaser's credit card
autorization information has, or could be, provided. Such
motiviation is unlikely at best because software purchasers are
unlikely to use a system to purchase software that would make the
purchaser's credit card information available to anyone who had
access to the software carrier. Further, even if Freeny were
modified to input purchaser identification in manufacturing unit
34, unit 34 is the manufacturing control unit which authorizes
reproduction unit 24 (see Section 13, page 5, 20060403) to write

the deciphered data to the carrier. Manufacturing control unit 34
is not shown and does not write data to the carrier. Modifying
Freeny to write purchaser identification to manufacturing control
unit 34 is not said to cause (and would not cause) such
identication information to be embedded on the carrier, as claimed.

3.   Non-functional claim language The specific identification
code parameters as claimed are said to be non-functional
descriptive material under MPEP 2106 IV B 1 (a) and (b). This is a
clear error in this rejection because the claimed identification
code parameters do have a functional interrelationship with the
statutory automated merchandizing system as claimed.

The cited MPEP section requires that the office consider the
claim as a whole. The claim includes means for writing the
software selected by the customer on a software carrier, means for
associated the specified parameters of the identification code with
the software and means for embedding the specified parameters of
the identification code on the carrier. As a result, three of the
claim elment structures are functionally involved with the claimed
identification code so that the automated merchanizing system
dispenses software via a carrier so that the identification code on
the carrier is associated with the software on the carrier.

By uniquely associating the software and software carrier with
the purchaser, in a manner acceptable to a purchaser, the automated
merchandizing system delivers software via a carrier which prevents
or reduces unauthorized copying of the software because the
purchaser of software, if it is unlawfully copied, can be
determined. Purchasers are therefore unlikely to permit unlawful
copies to be made. That is, software lawfully delivered via
carrier to purchaser A, if copied and in the possession of person
B, can be traced back to the lawful purchaser A via the
identification codes as claimed. Similarly, software in the
possession of person B can easily be determined to have been
purchased by another, via the identification codes as claimed.

Thus, as a result of these and other functions of the identification code paramenters embedded by the system as claimed, and the functional relationships with other claim elements noted above, the claimed system provides selected software to a custer via a software carrier on which is embedded purchase/purchaser specific parameters preventing or reducing unlawful copies of the software. The claim identification code parameters clearly provide function.

The system as claimed cannot be obvious over Freeny (whether or not modified), which uses owner identification to control deciphering of software to be written to a carrier and purchaser information merely to authorize a credit card purchase of the software.

4.   Status of claims By agreement, the supplemental amendment after final filed 10/03/06 will not be entered so that the supplemental response filed by private PAIR on 10/6/06 may be entered.   Pending claims therefore now include 3 almost identical claim groups:

- claim 1, and dependent claims, as rejected on 04/06/06,
- claim 78, and dependent claims, as submitted in draft to the Examiner on 10/02/06 based on discussions that day, and
- claim 91, and dependent claims, as formally submitted on 10/03/06 based on discussions that day.

Based on discussions with the Examiner on 10/02/06, claim 78 differs from claim 1 in that the following additional claim language was inserted at the end of the "means for embedding …" limitation in claim 1:
"and for preventing copying of software, copied onto the software carrier, by recording the embedded identification code together with program identification code comprising at least one of the following program identification parameters: program identification and a serial number for the program copy".

Based on discussions with the Examiner on 10/03/06, claim 91 differs from claim 1 in that the following additional claim language was inserted at the end of the "means for embedding …" limition in claim 1:

"; said identification code prevents copying by identifying the selected software provided to the customer on the software carrier".

The errors in the examiner's rejections and omissions of essential claim elements described above also apply to independent claims 78 and 91.

4. <u>Withdrawal of finality.</u> The rejections based on the Examiner's interpretation that the claimed identification code parameters are non-functional descriptive material were first made in this first action final rejection. These rejections were not caused by applicant's amendment because claim 1, as rejected, is in the same form as issued. Applicant therefore respectfully requests that if these claims are not allowed, the finality of the rejection be withdrawn.

Respectfully Submitted,

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Date: 10/6/2006   Norman E. Brunell Reg. No. 26,533

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